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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,172	10/04/2000	Helmut Schreiner	1438-30	7232
7590	01/27/2004		EXAMINER	
Donald R Studebaker Nixon Peabody 8180 Greensboro Drive Suite 800 McLean, VA 22102			TREMBLAY, MARK STEPHEN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

09/581,172

## Applicant(s)

SCHREINER, HELMUT

## Examiner

Mark Tremblay

## Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 20-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 20-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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Applicant: Schreiner

Filing date: 10/4/2000

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 10, 12-14, 32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent #6,025,054 to Tiffany, III ("Tiffany" hereinafter). Tiffany teaches a label (a smart card is inherently a "label" for people, cars, semiconductor wafer carriers, luggage, etc. etc.) comprising at least one electronic component, characterized in that the electronic component is cast in synthetic material (polyurethanes made by condensation reactions of isocyanate and a polyol; see column 6, lines 39-41).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Tiffany.

Re claim 20, Official Notice is taken that polished silicon molds are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use polished silicon molds for the molding process of Tiffany, in order to produce a smooth surface, and avoid sticking, as is well known in the art. See references cited by Examiner but not relied upon.

Re claim 11, it is well known to print on the synthetic material, or provide it with color for aesthetic purposes. Also, the claimed color has not been described or claimed to have any significant utility.

Claims 2-7, 9, 20-25, and 33-37 are rejected under 35 U.S.C. § 103 as being unpatentable over Tiffany in view of U.S. Patent #5,469,363 to Saliga et al, further in view of U.S. Patent #5,153,842 to Dlugos, Sr. et al. ("Dlugos" hereinafter). Tiffany teaches the features of the invention but does not teach that the label may be adhesively affixed to an item. Dlugos teaches that a label may be adhesively affixed to an item. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to affix the label with an adhesive to an item, because such a label can provide useful information about the item in electronic form, as taught by Dlugos. The combined teachings do not suggest that the label have an adhesive backing. Saliga teaches that the label may have an adhesive backing. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the label directly with an adhesive backing because this would allow the label to be directly affixed to the item, as taught by Saliga. The combined teachings suggest that there will be situations in which a permanent label is desirable, and times when a removable label is desirable. Known adhesives can accommodate both situations.

Re claims 5-6 and 37 Official Notice is taken that adhesive, siliconized foils are notoriously old and well known in the label art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. Most children in the US are familiar with so called "ez-peel" labels. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide siliconized ez-peel foils as a backing for the adhesive labels of the combined teachings because ez-peel technology allows a label with an adhesive backing to be rendered available for affixing at the desired time of use, not before, when the labels are not ready to be used.

Re claims 20-25, support materials are well known in the art, and known to have printing thereon.

Claims 2, 7-9, and 33-36 are rejected under 35 U.S.C. § 103 as being unpatentable over Tiffany in view of U.S. Patent #5,478,991 to Watanabe et al. ("Watanabe" hereinafter). Tiffany teaches the features of the invention but does not teach that the label may be mechanically affixed to an item with a ribbon. Watanabe teaches that a label may be mechanically affixed to an item with a ribbon. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to affix the label with a ribbon to an item, because such a label can provide useful information about the item in electronic form, as taught by Watanabe, and such an arrangement avoids an adhesive problem when items such as luggage may be damaged by a strong adhesive, may lose a label attached by a weak adhesive, and provide points for convenient mechanical attachment of a label, e.g. by a ribbon.

Claims 26-32, are rejected under 35 U.S.C. § 103 as being unpatentable over Tiffany in view of U.S. Patent #5,777,903 to Piosenska et al. ("Piosenska" hereinafter). Tiffany teaches the features of the invention but does not teach that the label may include a display. Piosenska teaches that a smart card may contain a display. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the smart card of Tiffany to include a display as taught by Piosenska et al. in order that the tag may display the contents of it's memory, as taught by Piosenska.

### **Remarks**

The Applicant has amended all of the claims to include the limitation that the synthetic material is "applied by flowing the synthetic material from a nozzle in a drip process to form the protective cover layer". However, the claim is drawn to a "label". This amendment therefore essentially adds a product by process limitation. Reviewing the specification, examiner found only one mention of "drip process" at the last line of page 4. No description of this process was given. Examiner searched the prior art databases to find the meaning of the term "drip process" as a "term of art". Examiner

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was unable to discern any standard meaning for this term. Two examples of patents using the term "drip process" are cited.

The application has failed to establish that there would be any difference in a label manufactured using the claimed "drip process" vs. using any other known process. Because of this failure, Examiner is unable to assign any patentable weight to the limitation added by the amendment. See MPEP 2113.


With respect to claim 37, Examiner regrets any inconvenience to Applicant because of the typographical error in the previous office action. In Examiner's view, claim 37 deals with features of the invention that are also dealt with by other claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### **Voice**

Inquiries for the Examiner should be directed to Mark Tremblay at (571) 272-2408. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (571) 272-2398. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

  
**MARK TREMBLAY**  
**PRIMARY EXAMINER**

1/24/04